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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,609	12/28/2000	Marc Traylor	D-6904	8543

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EXAMINER

SZUMNY, JONATHON A

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 02/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,609	TRAYLOR, MARC	
	Examiner	Art Unit	
	Jon A Szumny	3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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This is the fourth office action for application number 09/751,609, Resilient Magnetic Paintbrush Holder, filed on December 28, 2000.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy '158.

With respect to claims 1, 4, 7, 11-14, 18 and 19, Nagy '158 discloses a holder (figure 1) comprising a clamp (28, 30, 32, 33 and 34, figure 1), a magnet (48, figure 1), a magnet holder (40, 42, 44 and 46, figure 1) and a resilient member/length of resilient material/spring (figure 1) having a proximal portion (figure 1) attached to the clamp and a distal portion (figure 1) attached to the magnet; wherein the resilient member (24), the magnet holder (46) and at least a portion of the clamp (28, 30, 32, figure 2) constitute a single molded structure; wherein the holder further comprises a paint can (6) and a paintbrush (10); wherein the resilient member (24) inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet. Regarding claims 2, 5, 8 and 15, the member inherently acts as a spring

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whenever a force is applied perpendicularly to it. With respect to claims 3, 6, 9, 16, member 24 is inherently resilient due to the material it is made from.

Regarding claims 10, 17 and 20, Nagy '158 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that the resilient member could be selected so as to limit acceleration of the paintbrush to any number of certain degrees, and any specific degree, including to no more than 0.75 g would clearly be a design choice (so as to satisfy specific user preferences) and hence is not considered patentable.

Response to Arguments

Applicant's arguments filed January 15, 2003 have been fully considered but they are not persuasive.

On page 4 of the remarks, it appears the applicant is making an argument that the resilient member of Nagy '158 does not have a force constant. The resilient member of Nagy '158 is "*bendable flat faced metal*" (column 1, lines 52-53). Without a doubt, the resilient member of Nagy '158 has a force constant. As far as that force constant specifically being selected to produce a displacement of the distal portion when subjected to a shock *so that the paintbrush attached to the magnet does not slide off the magnet*, Nagy '158 also inherently suggests such a feature.

More specifically, for instance, in the invention of Nagy '158, when the paintbrush is attached to the magnet, there is obviously, clearly, and inherently some mechanical

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shock applied to the paintbrush, and there is obviously, clearly, and inherently some displacement of the distal portion upon the mechanical shock applied to the paintbrush, yet, the paintbrush obviously does not slide off the magnet, since, for instance, in figure 1 of Nagy '158, the paintbrush is in fact attached to the magnet. Therefore, Nagy '158 does in fact teach the resilient member to have some force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

In the middle of page 6 of the remarks, the applicant alleges that the force applied to the member (24) is "not perpendicular." When the paintbrush is, for example, removed from the holder, the force is substantially perpendicular. Therefore, the conditions are not contrary as alleged by the applicant.

Further, on the bottom of page 6, how can the applicant contend that the member (24) is a "rigid bracket" when it is specifically stated in Nagy '158 (column 1, lines 52-53) as being a "length of *bendable* flat-faced metal?"

On the top of page 7 of the remarks, the applicant discusses the failure of Nagy '158 to teach the force constant of member (24) to be capable of reducing the maximum acceleration of the brush by a factor of 10. This has not been claimed.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). More specifically, since it has already been proved that Nagy '158 does in fact teach the resilient member to have some force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet, it would have been obvious to an ordinary artisan that the resilient member could limit acceleration of the paintbrush or object to any number of certain degrees, and any specific degree, including to no more than 0.75 g would clearly be a design choice and hence is not considered patentable.

On the middle of page 9 of the remarks, the applicant alleges that the Examiner did not rebut or address the applicant's "facts" of September 16, 2002 regarding the resilient member, the magnet holder and a portion of the clamp constituting a single molded structure. Such is not true. The Examiner did in fact address the applicant's comments on page 4, lines 6-13 of the office action mailed October 15, 2002. Further, on the top of page 10, it appears the applicant has misinterpreted what the Examiner previously stated. The applicant states "The structural differences between a single molded structure and an assembly of parts held together by fasteners or other means is plainly manifest to one of ordinary skill in the art. Nagy does not teach... ..a single molded structure." The Examiner disagrees. The Examiner is referring to the magnet holder as member 46 (it inherently "holds" the magnet, without it the magnet could

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easily be disengaged), the resilient member as 24, and a portion of the clamp as 28, 30 and 32, generally. All three of these members constitute a "single molded structure."

Finally, on the bottom of page 10 and the top of page 11 of the remarks, the applicant contends that the Examiner provided no motivation and solely utilized knowledge gleaned from the applicant's disclosure. The Examiner disagrees. The Examiner has provided motivation and reasoning for all rejections made in this office action, and has already previously addressed the claim limiting the acceleration of the paintbrush to no more than 0.75 g.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Jon Szumny
Patent Examiner
Technology Center 3600
Art Unit 3632
February 3, 2003

RAMON O. RAMIREZ
PRIMARY EXAMINER
ART UNIT 355-3632